REMARKS

Claims 4, 7, 10-12, 21, 22, 29 and 30 are pending in the application and are rejected.

The Examiner in the official action has attempted to characterize the Applicant's invention. In this regard Applicant's respectfully submit that the Examiner has not accurately described Applicant's invention. In particular, Independent claims of the present application include the steps of automatically analyzing a digital image media file that at a first party for determining if a portion of the at least one digital image file matches an image content identifier. Secondly, the claims further recited that the image content identifier has an associated electronic address of a second party. Thus, the claims not only require the analyzing to determine if the image content identifier is present, but also that the image content identifier must have an associated electronic address of a second party. The claims still further require automatically forwarding the digital image from the first party to the electronic address of the second party over the communication network if the image content identifier matches a portion of the image. Thus, in the present invention there are a number of steps that happen automatically that rely on analyzing a digital image to determine if an image content identifier exists and then automatically forwarding the image to a third party in accordance with the electronic address associated with the image content identifier. Applicant's respectfully submit that the prior art singling or in combination does not teach or suggest the invention as claimed by Applicants.

Applicants would also like to respond to certain statements made by the Examiner in the section entitled "Response to Arguments". In particular the Examiner states that there is a disputed term "image content identifier" and that this term is has been identified by Applicant in the specification on page 6, lines 10-11. The Examiner is correct in that an icon of a person's face may serve as an image content identifier. However, the present invention is limited as the Examiner sated. As setforth on page 14, lines 31-32 of the present application it states "While the icon tool has been described as a recognized image contained of a particular individual, the icon tool can represent any theme, for example, any sports, hobby or item". The Examiner also states "Applicant's position is further undercut by the fact that Applicant's specification also relies upon facial

recognition software to generate image content identifiers. While facial recognition software can be used in the present invention this is not required by the claims of the instant application. The claims require the image be analyzed to determine if an image content identifier is present. There is no requirement in the claims that it be accomplished using face recognition. Further, the Examiner also states that Capps's characteristics of a person that are used to identify a person in an image is clearly analogous in functionality to Applicant's image content identifier. The Examiner further states that Capps further discloses that an electronic address is associated with these characteristics, which enable transmitting the digital file to the identified person. In this regard the Examiner refers to paragraph 0005, 0021, 0062.

Paragraph 0005 merely describes use of hyperlinks to go from one place to a second place. Paragraph 0021 deals with the automatic retrieval of messages from an account server. As setforth in paragraph 0021 if a person is found, the system and process of the working example automatically determines whether the person has corresponding message account. This is accomplished by automatically querying a messing account server. The passage in paragraph 0062 refers to the electronic document illustrated in Fig. 4 which simply setsforth that hyperlinks may be provided in the electronic document. Furthermore, with regard to Goldberg, Publication 2004/0008872, this reference is not appropriate for use in rejecting the instant application. In particular the subject publication is based on a filing of July 8, 2003, which is a continuation of application 10/360,197 filed on February 6, 2003 which has been abandoned. The abandoned application is the CIP of an application that matured to U.S. Patent 6,526,158. It is the U.S. Patent that has the appropriate earlier filing date and not the CIP on which the Examiner has rejected the application. With regard to the Goldberg '158 patent, this is directed to storing of captured images. In particular, captured images are examined, or symbolic or facial features which are then stored. There is no teaching or suggestion in Goldberg to provide an icon identifier that provides the functionality of associating an electronic address of a second party that can be automatically forwarded from the first party to the electronic address after automatically analyzing the digital image file for the content identifier.

Applicant's also respectfully submit that there is no motivation to combine the references as suggested by the Examiner. The Examiner cited that

there are three possible sources for motivation to combine the references which include the nature of the problem to be solved, the teachings of the prior art and the knowledge of persons of ordinary skill of the art. Examiner goes on to state that the strongest rationale for combining references are recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent that some advantage or expected beneficial results would have been produced by their combination, however, there still must be some clear basis for combing the reference as suggest by the Examiner. Applicant's respectfully submit that the Examiner has used hindsight in a manner to piece meal individual elements in three references in an attempt to arrive at Applicant's invention.

The primary reference to Capp upon which the Examiner has based the rejection is directed to a method and system for automatically scanning or parsing an electronic document or information displayed on computer display device to find any data that represents at least one person and providing information relative to the identified person. (see abstract and paragraph 0009). Capp locates the electronic address of the graphical data representing a person that has been found. The user is then notified that the person has been identified.

The Goldberg reference is directed to where personalized images of patrons in an entertainment venue, such as a theme park are obtained. In on embodiment a identification device such as a card or pin is used to is matched images to the patron. In one embodiment Direct Subject Recognition is used for this matching purpose, see Col. 11 line 49 to Col 12. line 21. One would hardly look to the matching feature of Goldberg to the finding of data feature of Capp. The Lloyd-Jones et al. reference is directed to a method and apparatus for annotating an image. In this reference there is manual associating of data to images. These references are directed to different problem each having it's own solution. Applicants respectfully submit that there is no basis to combine the reference as suggested by the Examiner. Further even if combined they still fail to teach or suggest the claimed invention.

Capps fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by

Applicants' independent claims. As admitted by the Office Action, Capps does not disclose an image content identifier.

> In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "'usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term.'" Id. (quoting *Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576*, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips,* 415 F.3d at 1317.

Rather, Capps' program module parses an electron document to identify *a* person, retrieves data relevant to the person, and compares the retrieved data to at least one electronic database using conventional techniques. *See* [0053]. Applicants respectfully submit that the electronic database is not an image content identifier as recited and defined by Applicants. More specifically, Capps identifies "characteristics of a person or persons" (i.e., any data that represents at least one person. *See* Abstract) and then compares these characteristics to information contained in a database. *See* [0052] and [0053]. In sharp contrast, Applicants' claims require analyzing a digital image media file for determining if a portion of said at least one digital image file matches an image content identifier. Furthermore, Capps fails to disclose an image content identifier having an associated electronic address of a second party. Moreover, if Capps fails to disclose an image content identifier, Capps' cannot be said to disclose an image content identifier having an associated electronic address of a second party.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. Goldberg was cited to disclose facial identifier functionality. Goldberg does not disclose image content identifier having an associated electronic address of a second party.

Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest at least automatically analyzing

a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. Rather, Lloyd-Jones discloses that a user can annotate an image by associating metadata with icons and then dragging and dropping the icon on an image. *See* Fig. 1, step 109 and [0029, 0030]. The metadata associated with the selected icon describes a person's name and email address, and is stored in a list associated with the image file in a database along with the position where the icon was dropped within the image. *See* Fig. 1, step 113 and [0039]. If a user wished to e-mail images to another person, an e-mail application must search another list associated with another image. *See* [0039]. Accordingly, there is nothing in Lloyd-Jones that discloses an image content identifier having an associated electronic address of a second party.

It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated electronic address of a second party as previously discussed.

Therefore, in view of the above remarks, Applicants' independent claims and their dependents are patentable over the cited references.

As an additional argument, Applicants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

> 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
> 2) there must be a reasonable expectation of success; and
> 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
> (M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary

skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Goldberg fails to provide any suggestion to implement or otherwise be combined with an apparatus for annotating an image as described in Lloyd-Jones. Moreover, Lloyd-Jones fails to provide any suggestion to implement or otherwise be combined with a system for recognizing a patron's face as described in Goldberg.

Thus, Appellant respectfully contends that a *prima facie* case of obviousness has not been established as no "clear and particular" evidence of motivation to combine can be identified.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.